UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,974	10/09/2003	Toshio Yamamoto	VTN629NP	7789

27777 7590 05/19/2005

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER	
PORTER, RACHEL L	
ART UNIT	**PAPER NUMBER**
3626	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/681,974	YAMAMOTO ET AL.	
	Examiner	Art Unit	
	Rachel L. Porter	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/25/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed on 1/25/05. The IDS filed 1/25/05 has been entered and considered by the Examiner. Claims 1-17 are pending in the application and have been examined.

Claim Objections

2. Claims 11-12 are objected to because of the following informalities:

As per claims 11-12, the meaning of the term "contact item" (in line 7 and 10 of claim 11 and line 5 and 9 of Claim 12) is unclear. The examiner interprets the meaning of the term "contact item" to mean a prescription and specifically a prescription for contact lenses. The examiner recommends amending the claim to clarify this term.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Number 2004/0019794 to Moradi in view of US Patent Number 5,845,255 to Mayaud.

Moradi is directed towards a method and system for delivering prescription medicine while Mayaud is directed towards a prescription management system.

As per claim 1, which is directed towards a method of selling a prescribed product to a consumer via an online ordering system managed by or on behalf of a prescribed product manufacturer, Moradi teaches the steps of registering at least one authorized reseller of at least one product (Figure 9 and Section [0018]), registering at least one consumer to purchase at least one product on behalf of at least one patient for whom the product has been prescribed (Figure 7 and Section [0016]), assessing at least one approved prescription writer for the at least one product for the at least one patient (Section [0038]), accepting an approved prescription for the at least one product for the at least one patient approved from the prescription writer (Section [0039]), and issuing at least one product to the consumer in accordance with the calculated approved prescription (Section [0043]). The step of registering the customer is responsive to an invitation sent to the customer, by the ordering system for the customer to register on behalf of at least on authorized reseller. (Figure 7 and Sections [0118,0131]).

Moradi fails to teach or suggest the step of performing at least one calculation on the approved prescription to generate a calculated approved prescription for the at least one product for the at least one patient and an actual wear schedule (dosage amounts based on a time period), however this feature is known in the art as evidenced by

Mayaud (Col. 26, Ln. 39-Ln. 60). At the time the invention was made, one of ordinary skill in the art would have been motivated to add this dosage calculation feature to the system of Moradi in order to create a prescription management system with a minimized need for information, as recited in Mayaud (Col. 27, Ln. 13-18).

Neither Moradi nor Mayaud teach a feature wherein the calculated approved prescription includes a maximum amount of prescribed product that may be purchased under the calculated approved prescription, however, the examiner takes the position that a prescription, by its very definition, includes a maximum amount that can be purchased with each order (including the initial order and subsequent refills) and therefore in the system of Moradi the consumer would not be able to order more than an amount that has been prescribed for a particular user of the prescription.

As per claim 2, the combined system of Moradi in view of Mayaud includes managing at least two prescriptions each directly correspondent to one of at least two patients (Moradi, Abstract and Section [0160]).

As per claim 3, in the combined system of Moradi in view of Mayaud prescriptions can be ordered online and the specific types of prescriptions are not mentioned. The examiner therefore takes the position that ordering contact lenses is within the scope of the combined system of Moradi in view of Mayaud (Moradi; Section [0203]).

As per claim 4, the combined system of Moradi in view of Mayaud includes performing at least one calculation (Mayaud; Col. 26, Ln. 39-Ln. 60).

As per claims 5 and 6, in the combined system of Moradi in view of Mayaud the step of issuing comprises selling and delivering the product to the customer (Moradi; Section (0200]).

As per claim 7, in the combined system of Moradi in view of Mayaud the step of issuing comprises selling the product to at least one reseller and delivering the product to the customer (Moradi; Section [0035]).

As per claims 8-9, in the combined system of Moradi in view of Mayaud there is a charge account dedicated to the reseller (doctor) and the account is set up during the registration process (Sections, [0131]-[0133 and [0148]).

As per claim 10, in the combined system of Moradi in view of Mayaud the step of assessing the approved prescription writer (doctor) comprises registering a doctor affiliated with a reseller. Furthermore, the doctor cares for one or more patients (Sections [0108]-[0109]).

As per claim 11, in the combined system of Moradi in view of Mayaud the step of inviting the customer comprises a) receiving a calculated approved prescription from the authorized reseller (Mayaud; Col. 26, Ln. 39-Ln. 60), assessing that the customer related to the calculated approved amount is not registered (Moradi; Section [0035]), receiving, from the authorized reseller, at least one contact item (prescription) for the customer related to the calculated approved prescription (Moradi, Section [0200]), and contacting the non-registered consumer based upon the contact item (prescription) and inviting the customer related to the calculated approved prescription to register with the system (Moradi, Figures 3,8 and Section [0035,0160]).

As per claim 12, in the combined system of Moradi in view of Mayaud comprises the steps of assessing that the at least one customer related to the calculated approved prescription is not registered (Moradi: Section [0035]), receiving, from the authorized reseller, at least one contact item (prescription) for the customer related to the calculated approved prescription (Moradi; Section [0200]); contacting the non-registered consumer based upon the contact item (prescription) and inviting the customer related to the calculated approved prescription to register on the ordering system (Moradi, Figures 3,8 and Section [0035,0160]); and receiving a calculated approved prescription from the authorized reseller (Mayaud; Col. 26, Ln. 39-Ln. 60).

As per claim 15, in the combined system of Moradi in view of Mayaud the consumer (doctor) may order products for multiple patients (Moradi; Sections [0050]-[0051]).

As per claim 16, in the combined system of Moradi in view of Mayaud multiple products are shipped to the consumer in one shipment (Figure 10 and Section [0200]). Claim 17 includes the same limitations as claim I but is directed towards a system rather than a method and is therefore rejected for the same reasons as claim 1 is rejected (see the paragraph for the rejection of claim 1).

5. Claims 13-14 are rejected under 35 U.S.C. 103(a) as applied to Claims 1, 11 and 12 above over Moradi in view of Mayaud.

Moradi in view of Mayaud fail to teach or suggest inviting the customer to register by an email or phone invitation, however the examiner takes the position

that these features are well known in the art and the examiner takes Official Notice. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included an email and/or phone invitation system in the combined system of Moradi in view of Mayaud with the motivation of providing an efficient means of informing a user to register with the automated prescription sales system.

Further, since the knowledge and use of telephone and email invitations, in general, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. In re Graves, 36 USPQ 2d 1697 (Fed. Cir. 1995).

Response to Arguments

6. Applicant's arguments filed 1/25/05 have been fully considered but they are not persuasive.

It is noted that the Applicant has amended claims 1 and 10-12. The Examiner has provided additional citations to address the new limitations as appropriate.

(A) On page 6 of the 1/25/05 response, the Applicant argues that the claimed invention is distinct over the prior art of record because "it is managed by or on behalf of a prescribed product manufacturer."

In response to applicant's arguments, the recitation of "system managed by or on behalf of a prescribed product manufacturer..." has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Moreover, even if this limitation were incorporated into the body of the claim, it is respectfully submitted that the alternative language in the claim "by or on behalf of a prescribed product manufacturer" would fail to significantly narrow the scope of the claim. In other words, as the Examiner understands sales and marketing systems, most systems may be broadly construed as selling products "by or on behalf of a manufacturer." Furthermore, the current claim language fails to clearly define the roles/steps performed by the different parties/participants involved in claimed invention.

(B) On page 6 of the 1/25/05 response, the Applicant argues the claimed invention is an improvement over the prior art of record because it reduces inventory storage and administrative costs.

In response to applicant's argument that the claimed invention is an improvement over the prior art of record because reduces inventory storage and administrative costs, the fact that applicant has recognized another advantage which would flow naturally

from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Furthermore, while the Applicant argues that Mayaud and Moradi fail to teach or suggest the advantages offered by the Applicant's invention, it is noted that the features upon which applicant relies (i.e., reducing costs by permitting *patients and consumers to get products without returning to the authorized reseller*) are not clearly recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(C) Applicant further argues that Moradi and Mayaud do not disclose the step of calculating an approved prescription.

The Examiner disagrees with the Applicant's interpretation of the prior art. Mayaud discloses a system/method which can calculate the proper dosage for a prescription and can also calculate expiration dates for prescriptions. (col. 26, line 39-col. 27, line 3). Furthermore, the Examiner cited motivation from the secondary reference support the combination and the holding of obviousness in the rejection.

(D) On page 7, the applicant argues that examiner has failed to address all of the limitations of claim 17.

In response to applicant's argument that the Examiner has failed to address the limitation allowing the consumers to "order prescribed products directly from a

manufacturer of prescribed product", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

It should be noted that the portion of claim 17 cited by the Applicant requires only that the consumer system and prescription management system be communicatively linked. The explanation for the two systems being communicatively linked only describes how the system may be used in the future, but does not alter the structure of the components in the system. Moreover, insofar as the recited prescription management system apparently comprises a function and not any true structural components, it is unclear to the examiner how these systems may be linked (communicatively or otherwise) to realize any of the prescription management system's functionalities.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Broderick et al (USPN 6,746,120) discloses a system/method for ordering customized contact lenses from a manufacturer.

- 1-800 Contacts discloses a online system/method for ordering contact lenses.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RP
RP

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600